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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,715	05/04/2001	Steven M. Rothman	1908-95650	9398

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BLUMENFELD, KAPLAN & SANDWEISS, P.C.
168 NORTH MERAMEC
4TH FLOOR
CLAYTON, MO 63105-3763

EXAMINER

GIBSON, ROY DEAN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 01/30/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

SR

Office Action Summary	Application No. 09/905,715	Applicant(s) ROTHMAN, STEVEN M.	
	Examiner Roy D. Gibson	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Paper

Applicant's response to Office Action filed 17 November 2003, as Paper No. 10, is acknowledged. Claims 1-9 and 11-12 are currently pending.

Prior Rejections or Objections

The following comments pertain to the rejections or objections in the most recent Office action, Paper No. 8, mailed on July 15, 2003.

The affidavit to negate the Hill et al. reference was accepted. However, the affidavit to establish the invention was conceived and reduced to practice prior to the filing date of the Lesser et al. application was not acceptable at the time. The affidavit by Dr. Matthew Hill provided in Paper No. 10 above, documenting his discussions with the inventor, Dr. Steven Rothman, also is insufficient evidence to overcome the Lesser et al. reference because the critical description(s) of the invention in the form of drawings, records, photographs or other design specifics are still lacking (see 35 CFR § 1.131). Therefore, the prior rejections are repeated below and made final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Lesser et al. (6,248,126).

As to claims 1 and 11, Lesser et al. disclose a method for treating a patient having epilepsy comprising:

locating a focal site that is the source of an intractable focal seizure, the focal site being located on a brain's neocortical surface;

establishing direct physical contact between the focal site and a cooling means:
and

activating the cooling means and cooling the focal site to abort the intractable focal seizure (col. 1, line 15-col. 2, line 22, col. 3, lines 1-32, col. 4, line 56-col. 5, line 3, col. 5, lines 27-55, col. 7, line 28-col. 8, line 44 and col. 9, lines 14-30). Note that claim 10, is identical to claim 1, except for "rapidly" in line 7, which is a broad and undefined limitation that does not patentably distinguish claim 10 over claim 1.

As to claims 2-3, Lesser et al. disclose that the focal site is determined by a cortical mapping process accomplished by establishing physical contact between a focal site and a cooling means and activating the cooling means to cool the focal site and eliminate the site as a seizure origin site (col. 7, lines 28-50 and col. 8, lines 33-44).

As to claims 4-7 and 12, Lesser et al. disclose manual activation of a Peltier chip to a temperature between 24-30 °C, which is a decrease of 7-13 °C (col. 9, lines 26-30).

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As to claim 8, Lesser et al. disclose activating at a frequency and duration so that the seizure is reduced (inherent in the process since the objective is the same as claimed by the applicant).

As to claim 9, Lesser et al. disclose that the activation step is determined by a seizure detection (col. 8, lines 33-44).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 703-308-3520. The examiner can normally be reached on M-F, 7:30 am-4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

January 28, 2004


Roy D. Gibson
Primary Examiner
Art Unit 3739